

REMARKS

The Office Action mailed July 21, 2003, has been carefully considered. The present Response is intended to be a complete response thereto and to place the case in condition for allowance. Claims 11-25 are pending. Claim 26 has been added. Support for claim 26 is found in Figure 1, where the legs are substantially straight.

Applicant gratefully acknowledges the courtesy of a personal interview on October 20, 2003, in which Examiner Kramer and Minh-Quan K. Pham discussed several issues in respect to the pending application. During the interview, the Sergeant reference was discussed with regard to the claims. It was Examiner's interpretation that the "legs" of the present claims read on the combination of the sides 12 and 14 and the cords 16 and 18 of Sergeant's tool, and that the ends 16B and 18B of Sergeant are in "reversible engagement." The Examiner is of the opinion that although the sides 12 and 14 make sharp bends 16A and 18A to form the cords 16 and 18, the combination of the sides 12 and 14 and the cords 16 and 18 are nevertheless considered "legs." The Examiner also suggested that a claim amendment to specify that the leg is formed without a sharp bend or something to that effect would overcome the Sergeant reference. No agreement was reached.

THE CLAIMS ARE NOT OBVIOUS

Claims 11-16 and 22-25 stand rejected under 35 U.S.C §103(a) as being obvious over Sergeant (U.S. Patent No. 4,387,610) in view of Kaufman (U.S. Patent No. 5,192,106). Claim 22 stands rejected under 35 U.S.C §103(a) as being obvious over Seyfriedt (U.S. Patent No. 5,339,923) in view of Kaufman. Claim 23 stand rejected under 35 U.S.C §103(a) as being obvious

over Seyfriedt in view of GB 2 035 187 (GB '187). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143.

With regard to the rejection of claims 11-16 and 22-25 over Sergeant in view of Kaufman, the references, taken alone or in combination, fails to disclose every element of the invention as claimed. Neither Sergeant nor Kaufman disclose a pair of tweezers 1) having legs with one ends that are capable of “reversible engagement” as required by claims 11 and 22; or 2) that are made of “light metal profile by extrusion and by separation of said profile approximately transversely to said direction of extrusion” as required by claim 11.

Sergeant discloses a “force applying tool” which has no “legs” that can be brought into reversible engagement. The tool of Sergeant operates as a ram so that when manual pressure is exerted to the sides 12 and 14, the movable end or “jaw” 4 is forced into the fixed jaw 2. This tool has nothing in common with a pair of tweezers. Thus, contrary to the Examiner’s assertion, Sergeant fails to disclose a pair of tweezers altogether. According to Webster’s Third New International Dictionary, tweezers is define as “any of various small pincer-shaped tools for plucking, holding or manipulating (as for removing superfluous hairs or handling watch parts).” The page containing the definition is attached herewith for the Examiner’s convenience. The

page also shows a drawing of a pair of tweezers which clearly do not resemble the tool of Sergeant. Sergeant does not disclose a pincer at all.

Moreover, the tool of Sergeant do not have leg ends that are “capable of reversible engagement”. The unattached ends 16A and 18A of Sergeant do not come into engagement at all. When pressure is exerted on the sides 12 and 14, to close the jaw 4, the ends 16A and 18A do not come into engagement because the cords 16 and 18 hold the ends 16A and 18A apart. Thus, these end are not capable of “reversible engagement” as required by claims 11 and 22.

Even as alleged by the Examiner where the sides 12 and 14 and the cords 16 and 18, together, form “legs,” the ends 16B and 18B are not in reversible engagement. Theses ends are in permanent engagement by being permanently attached to the jaw 4. The parts of Sergeant’s tool that actually come into reversible engagement are the cords connecting the ends 16B and 18B to opposed ends 16A and 18A. Those cord cannot be consider ends because they are not located at the termination of the legs. If one compares FIGS. 1 and 2 where the ends 16B and 18B are in engagement in both figures and are never release from each other. Thus, these ends (16B and 18B) are in permanent engagement; not reversible engagement.

As admitted by the Examiner, Sergeant fails to disclose that the tool is form of “light metal”. As a matter of fact, Sergeant specifically disclose that the tool is “of unitary, molded or extruded, plastic construction, which eliminates assembly linkages and other separate parts” (see column 1, lines 28-30). Nevertheless, the Examiner avers that Kaufman teaches the use of “light metal” to make tweezers. The present invention, however, requires that the tweezers be formed of “light metal profile by extrusion and by separation of said profile approximately transversely to said direction of extrusion” (see claim 11). Although in column 3, lines 62-66, Kaufman discloses the spring steel and aluminum for making his tongs, the reference fails to disclose that

it is made “by extrusion and by separation of said profile approximately transversely to said direction of extrusion”.

Further, there is no motivation to combine the references. First, the tools of Sergeant and of Kaufman are completely different and one of ordinary skill in the art would not have been motivated to combine the teachings of the references. Second, Sergeant requires that the tool be made out of “plastic ... which eliminates assembly linkages and other separate parts” (see column 1, lines 28-30). Thus because Sergeant taught a specific advantage to using plastic, as opposed to other materials, constructing the tool of Sergeant from metal would have been contrary to the teaching of Sergeant. It is well known that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. *See* MPEP 2143.01.

Furthermore, in effect, Sergeant teaches that if his tool is made out of materials other than plastic, such as light metal, it would have required separate parts and assembly linkages. The present invention seeks to solve the problem articulated by Sergeant, i.e. making a pair of tweezers out of light metal without requiring separate parts and linkages. The present inventor recognizes that a pair tweezers can be made out of light metal without the disadvantages disclosed by Sergeant by practicing the present invention. Therefore, the present invention is unexpected result that has been discounted by Sergeant.

With regard to the rejection of claim 22 over either Seyfriedt in view of Kaufman, the references, taken alone or in combination, fails to disclose every element of the invention as claimed. In particular, neither Seyfriedt nor Kaufman discloses that the leg ends are “capable of being brought into reversible engagement with each other at their second ends by manual exertion of a closure pressure of at least about 150 g” as required by claim 22. Nevertheless, the Examiner alleges that such a closure pressure is obvious “in order for easy manual

manipulation.” Applicant respectfully assert that the Examiner’s allegation is baseless. First, the Examiner has not given a clear motivation for selecting a closure pressure of about 150 g and not more or less. If one of ordinary skill in the art is motivated to have a closure pressure for “easy manual manipulation” as alleged by the Examiner, he/she would have selected a very low pressure of 50 g or less and not 150 g. The Examiner appears to have misunderstood the significance of such closing pressures. It is very easy to make tweezers of any material and shape if a low closure pressure would suffice. In fact, light metal tweezers capable of replacing steel tweezers (which have closure pressure of above 100 grams) require such a relatively high closure pressure that, prior to the present invention, it is anything but obvious to achieve. The present invention provides tweezers made out of light metals that have the same closure pressure as those made of steel. Therefore, the present invention there is no motivation to modify the cited references to arrive at the present invention.

With regard to the rejection of claim 23 over Seyfriedt in view of GB ‘187, the references, taken alone or in combination, fails to disclose every element of the invention as claimed. Seyfriedt, as discussed above, fails to disclose a closing pressure of about 150 g. The Examiner relies on GB ‘187 to show “a pair of tweezers having a bulge or projection (16a and 16b) extending inwardly from each leg so as to limit deformation of the tweezers upon manual compression thereof.” However, because Seyfriedt is deficient in disclosing the closing pressure of about 150 g, this deficiency is not satisfied by GB ‘187. Accordingly, Seyfriedt in view of GB ‘187 do not render claim 23 obvious.

For the reasons cited, the Examiner fails to make a *prima facie* case of obviousness because the references, taken alone or in combination, fails to disclose every element of the presently claimed invention and because there is no motivation to combine the references.

Therefore, the claims are not obvious under the meaning of 35 U.S.C §103(a). Accordingly, the rejection should be withdrawn.

ALLOWABLE SUBJECT MATTER

Applicant gratefully acknowledges the Examiner's indication that claims 17-21 would be allowable if rewritten to include all the limitation of the base claim and any intervening claims.

PROPER DRAWING HAS BEEN SUBMITTED

Applicant gratefully acknowledges the approval of the substitute drawing filed June 19, 2003. Because the substitute drawing has been filed and no correction is required, Applicant respectfully submits that the drawing as filed on June 19, 2003, should be entered, and no drawing is required to be filed herewith.

CONCLUSION

Applicant has responded to the Office action mailed March 19, 2003. A substitute Abstract is submitted herewith. All pending claims are now believed to be allowable and favorable action is respectfully requested.

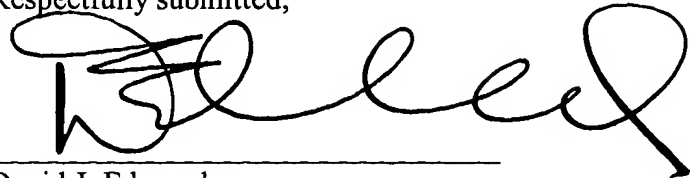
In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (000364-00123). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not

accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Edmondson', written over a horizontal line.

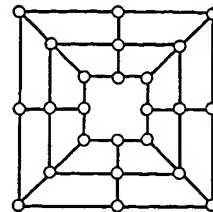
Date: October 21, 2003

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**twenty-first* ɪˈtʌnzɪˈfɪst(r) *n* -s [twenty-first + -er]: the celebration of a 21st birthday
 **twenty-five* ˈtʌnzɪˈfaɪ *adj*: being one more than 24 in number
 (**twenty-five years*) — see NUMBER table



twelve-men's morris board



tweezers